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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 09/595,204 | 06/16/2000 | Naokazu Nagasawa | 32739 | 1207 |
| 116 | 7590 | 05/18/2006 | EXAMINER | |
| PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108 | | | BRINEY III, WALTER F | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2615 | |

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/595,204 | NAGASAWA ET AL. | |
| | Examiner | Art Unit | |
| | Walter F. Briney III | 2615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 March 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8, 10 and 11 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 4 is/are allowed.
 6) Claim(s) 1-3, 5-8, 10 and 11 is/are rejected.
 7) Claim(s) 5 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 March 2006 has been entered.

Claim Objections

1. **Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.**

Claim 5 recites an interface means that is already recited in claim 10. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 6 is limited to “a telephone terminal device as claimed in claim 5,” as covered by Inoue in view of Sogaard and further in view of Sone. Claim 10 recites “an external memory device” and “a telephone directory memory.” Claim 6 recites “at least one of said at least one telephone directory memory comprises the external memory device.” Claim 6 is, therefore, indefinite because it modifies the two memory elements that were distinguished in claim 10 such that they become the same thing. Claim 6 does not appear to have any other reasonable interpretation and should be cancelled.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 1, 2, 5, 7, 8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (US Patent 6,618,586) in view of Sogaard Rasmussen, hereinafter Sogaard (US Patent 5,134,717), and further in view of Sone (US Patent 6,223,057).**

Claim 1 is limited to “a telephone terminal device.” As shown in the rejection filed 27 December 2005, Inoue anticipates “a temporary storage memory” 7. It was further shown that numbers in memory 7 could be registered in a telephone directory memory 6. However, the telephone directory memory 6 is not “an external memory device for storing numbers accessible by said [telephone terminal] device.” Furthermore, Inoue does not disclose “an interface means.” However, these deficiencies are overcome by an obvious modification.

In particular, Sogaard teaches a radiotelephone with repertory dialer. See Abstract. The telephone includes a first memory 34 and a second memory 36.

Advantageously, the second memory enables extension and portability of numbers that can also be registered in the first memory. See column 1, lines 7-25. In operation, a user of the telephone taught by Sogaard selects a memory position by entering one of the patterns 00-99. In this way, the telephone of Sogaard operates in a similar fashion as the telephone of Inoue, a user enters a phone number into memory without the aid of a plurality of directories.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an external memory 36 as taught by Sogaard for the purpose of enabling the extension of memory space and flexibility of stored telephone numbers.

Because the combination of Inoue and Sogaard fails to teach "a plurality of user selectable directories," all limitations of the claim have not been shown to be obvious. However, this deficiency is overcome by an obvious modification.

The rejections filed 27 December 2005 showed that it would have been obvious in view of Sone to register a telephone number stored in a temporary memory into another memory that is organized by a plurality of user selectable directories after making a call. As Sogaard merely modifies Inoue by extending the available memory (as evidenced by the transparent selection of spaces 00-99 of which 00-39 belong to the external memory and 40-99 belong to the internal memory), it follows that it would have been obvious to apply the directory structure taught by Sone to both the external and internal memories of said combination. Therefore, Inoue in view of Sogaard and further in view of Sone make obvious all limitations of the claim.

Claim 2 is rejected for the reasons presented above concerning claim 1 as well as the reasons set forth in the Non-Final Office Action filed 27 December 2005.

Claim 10 is limited to “a telephone terminal device.” Apropos the foregoing rejection of claim 1, Inoue in view of Sogaard in further view of Sone makes obvious “a temporary storage memory”, “an interface means” and “a plurality of user selectable directories.” The internal memory of Inoue corresponds to “a telephone directory memory different from said temporary storage memory.” Penultimately, Sogaard enables the storage of telephone numbers to any of an internal and external memory. Ultimately, Sone enables a directory structure for all available telephone number memory. These propositions evidence that the prior art combination of Inoue, Sogaard and Sone teaches that the external memory and the directory memory are associated with at least one user selectable directory and that a user can register a telephone number stored in the temporary storage memory in a selected one of any of said user selectable directories. Therefore, Inoue in view of Sogaard and further in view of Sone makes obvious all limitations of the claim.

Claim 5 is limited to “a telephone terminal device as claimed in any of claims 4 or 10.” As shown in the preceding section entitled *Claim Objections*, claim 5 fails to limit claim 10, and thus, is rejected for the same reasons.

Claims 7 and 8 are rejected for the reasons presented above concerning claim 10 as well as the reasons set forth in the Non-Final Office Action filed 27 December 2005.

Claim 11 is limited to "a telephone terminal device as claimed in any of claims 1, 4 and 10." The limitations of claim 11 were shown in the Non-Final Office Action filed 27 December 25 to be obvious in view of the teachings of Sone. See the rejection of claim 9. Therefore, Inoue in view of Sogaard and further in view of Sone makes obvious all limitations of the claim.

4. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Sogaard in view of Sone and further in view of Kurosawa (UK Patent Application 2,331,890).**

Claim 3 is rejected for the reasons presented above concerning claim 1 as well as the reasons set forth in the Non-Final Office Action filed 27 December 2005.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

5. **Claim 4 is allowed.**

Claim 4 is allowable over the cited prior art for the same reasons presented in the Non-Final Office Action filed 27 December 2005.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 5-8, 10 and 11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WFB



SINH TRAN
SUPERVISORY PATENT EXAMINER